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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,819	07/15/2003	Takaaki Matsufuji	0042-0484P	5901
2292	7590	12/05/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			WALLS, DIONNE A	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

10/618,819

**Applicant(s)**

MATSUFUJI ET AL.

**Examiner**

Dionne A. Walls

**Art Unit**

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 1 is objected to because of the following informalities:

In line 3, the word "sheer" should be changed to -- sheet --. Appropriate correction is requested.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman et al (US. Pat. No. 4,998,543).

Goodman et al discloses a smoking article exhibiting reduced sidestream smoke and, inherently, low fire-spreading characteristics since it teaches a wrapping of a tobacco rod in a double (i.e. inner and outer) layer of paper. The goal of the configuration of the inner wrapper is to slow down the burn rate of said wrapper, so it is provided with low calcium carbonate loading (corresponding to the claimed "loading material"), and little or no burn chemical additive. The outer wrapper is configured to have a higher burn rate and is provided with 2-10% by weight of a burn chemical additive and a higher calcium carbonate filler loading of 30-40%. (see entire document). While Goodman et al does not specifically state that the inner and outer wrappers have the claimed conductivity values, Applicant has, at least, inferred, in the instant

specification, that low calcium carbonate loading and burn additive amounts will increase heat conductivity, and high calcium carbonate loading and burn additive amounts will lower same. Therefore, the inner and outer wrappers of Goodman et al obviously have dissimilar conductivity values, since their filler and burn chemical values are distinctively different. And, regarding claims 3-4, based on Goodman et al's teaching that it is desirable to have an inner wrap with a low burn rate (see col. 2, lines 15-19), it follows that one having ordinary skill at the time of the invention would arrive at the claimed calcium carbonate amounts, for the inner wrap, after routine experimentation, to determine the optimal range which would allow for reduced burning of the inner wrap to reduce the visible sidestream smoke. Thus, since the claimed loading amounts have been met, the claimed conductivity values should inherently and/or obviously also be met.

Regarding claim 2, once the cigarette of Goodman et al is smoked, the tobacco section would inherently exhibit the claimed linear static burn rate.

Regarding claim 5, the inner wrap of Goodman et al has a porosity in the range of 20 – 40 CORESTA – which falls in the range of the claimed 5-30 CORESTA.

### ***Conclusion***

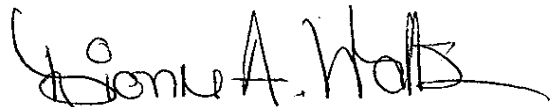
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls". The signature is stylized with a large, looped initial "D" and a long, sweeping horizontal stroke at the end.

Dionne A. Walls  
Primary Examiner  
Art Unit 1731

November 30, 2003